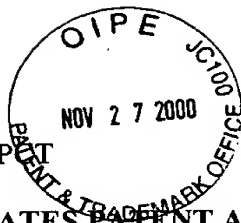


DOCKET NO.: 196838US0PCT



526 Rec'd PCT/PTO 27 NOV 2000

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF: Frank I. CARROLL, et al.

SERIAL NUMBER: 09/623,872

FILED: 11 September 2000

FOR: NOVEL OPIATE COMPOUNDS, METHODS OF MAKING AND METHODS  
OF USE

**RESPONSE TO NOTICE OF MISSING REQUIREMENT UNDER 35 U.S.C. 371**

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

5200

SIR:

Responsive to the notification of a Defective Response dated **26 October 2000**,  
Applicants are submitting two Notices from the International Bureau of PCT evidencing that  
James B. Thomas and S. Wayne Mascarella were recorded as Applicant/Inventors in the  
corresponding PCT Application No. PCT/US99/05131.

No fee is required.

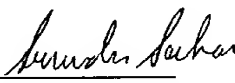
In light of the foregoing, this application is deemed to be in proper condition for  
examination and such favorable action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



**22850**

  
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Attorney of Record  
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UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: ASSISTANT COMMISSIONER FOR PATENTS  
Box PCT  
Washington, D.C. 20231

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/623872	CARROLL	F
		196838US0PCT
INTERNATIONAL APPLICATION NO.		
PCT/US99/05131		
LA. FILING DATE	PRIORITY DATE	
09 MAR 99	10 MAR 98	
DATE MAILED: 26 OCT 2000		

OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT  
FOURTH FLOOR  
1755 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202

NOTIFICATION OF A DEFECTIVE RESPONSE

1. ☐ The request for an extension of time (37 CFR 1.136(a)) filed \_\_\_\_\_ is defective because the required fee is missing/insufficient. Extension of time fees are listed at 37 CFR 1.17(a)(1)-(a)(5).
2. ☐ Applicant's response filed \_\_\_\_\_ was received in the Office on \_\_\_\_\_, which is after the expiration of the period for response set in the last Office notification mailed \_\_\_\_\_. This application will become abandoned unless applicant obtains an extension of time to reply to the last Office notification under 37 CFR 1.136(a).

3. ☒ Applicant's response filed Oct. 17, 2000 included the following items, the receipt of which is hereby acknowledged:

- ☒ Copy of the international application in:
  - ☐ a non-English language.
  - ☒ English.
- ☐ Translation of the international application into English ☐ which is defective for the reasons indicated on the attached Notice of Defective Translation.
- ☐ Processing fee (37 CFR 1.492(f)) ☐ which is insufficient.
- ☒ Oath or Declaration of inventor(s).
  - ☐ in compliance with 37 CFR 1.497(a) and (b).
  - ☒ not in compliance with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
- ☒ Surcharge (37 CFR 1.492(e)) ☐ which is insufficient.
- ☐ Copy of Article 19 amendments.
- ☐ Translation of Article 19 amendments into English.
- ☒ The International Preliminary Examination Report in English and its Annexes, if any.
- ☐ Translation of Annexes to the International Preliminary Examination Report into English.
- ☐ Preliminary amendment(s).
- ☐ Information Disclosure Statement(s).
- ☐ Assignment document.
- ☒ Power of Attorney and/or Change of Address.
- ☐ Substitute specification.
- ☐ Verified Statement Claiming Small Entity Status.
- ☐ Priority Document.
- ☒ Other: PCT/IB/304 & Letters regarding priority and cited documents

4. ☒ All of the requirements set forth in the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905 mailed October 17, 2000) have not been completed.

Applicant is required to complete the response within a time limit of ONE MONTH from the date of this Notification or within the time remaining in the response set forth in the Notification of Missing Requirements (Form DO/EO/905), whichever is the longer. No extension of this time limit may be granted under 37 C.F.R. § 1.136, but the period for response set in the Notification of Missing Requirements may be extended up to a maximum of five months.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

Enclosed: ☒ PCT/DO/EO/917 ☐ Notice of Defective Translation

Barbara A. Campbell

Telephone: 703-305-3631

**RECEIVED**

OCT 3 1 2000

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

## UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/623872	CARROLL	F 196838US0PCT
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ARLINGTON, VA 22202

## NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION

This application fails to contain an oath or declaration acceptable under 35 U.S.C. 371 (c)(4) for entry into the national stage in the United States of America. The period within which to correct these requirements and avoid abandonment is set in the accompanying Office action.

A new oath or declaration, identifying this application by the international application number and international filing date is required. The oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:

1. ☐ is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.
2. ☐ does not identify the specification to which it is directed.
3. ☒ identifies inventors that are not listed on International Application. (See attached page of IA.)
4. ☐ does not identify the citizenship of each inventor.
5. ☐ does not state the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

FAILURE TO SUBMIT AN OATH OR DECLARATION IN COMPLIANCE WITH 37 CFR 1.497(a) AND (b) WITHIN THE TIME PERIOD SET WILL RESULT IN FAILURE TO ENTER THE NATIONAL STAGE AND THE ABANDONMENT OF THE APPLICATION.

Additionally, the oath or declaration does not comply with 37 CFR 1.63 in that it:

1. ☐ does not identify the city and state or city and foreign country of residence or each inventor.
2. ☐ does not state that the person making the oath or declaration:
  - a. ☐ has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
  - b. ☐ acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.
3. ☐ does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.
4. ☐ does not state that the person making the oath or declaration acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and filing date of the continuation in part application which discloses and claims subject matter in addition to that disclosed in the prior application (37 CFR 1.63(d)).

Barbara A. Campbell

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